

REMARKS

The above amendments and these remarks are responsive to the non-final Office Action issued on April 12, 2007. By this Response, claims 9, 30, 31, and 47 are amended, and claims 1-8, 22-29 and 41-46 are cancelled without prejudice. Claims 57-59 are newly presented. No new matter is added. Claims 9-21, 30-40 and 47-59 are now active for examination.

The Office Action

The Office Action rejected claims 1-2, 5, 22-23, 26 and 41-42 under 35 U.S.C. § 103(a) as being unpatentable over Clarke (U. S. Publication No. 2006/0053043). Claims 3, 6-7, 9-12, 15, 20-21, 24, 27-28, 30-34, 37, 39-40, 43, 45-50, 53 and 55-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clarke in view of Morgan et al. (U.S. Patent No. 5,799,286). Claims 4, 8, 25, 29 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clarke. Claims 13-14, 16-19, 35-36, 38, 51-52 and 54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clarke in view of Morgan and Thompson (U.S. Patent 7,020,619).

The Rejections of Claims 1-8, 22-29 and 41-46 Is Moot

By this Response, claims 1-8, 22-29 and 41-46 are cancelled without prejudice. Accordingly, the rejections of claims 1-8, 22-29 and 41-46 is now moot.

The Obviousness Rejections Based on Clark, Morgan and Thomson Are Overcome

Claims 9-12, 15, 20-21, 30-34, 37, 39-40, 47-50, 53 and 55-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clarke in view of Morgan. Claims 13-14, 16-19, 35-36, 38, 51-52 and 54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clarke in view of Morgan and Thompson. By this Response, claims 9, 30 and 47 are amended. It is submitted that

the obviousness rejection based on Clark and Morgan is overcome because Clark and Morgan cannot support a *prima facie* case of obviousness.

Claim 9 is amended to ensure that the term “financial institution” is not a mere reference in the claim preamble, but in fact is extensively used throughout the body of the claims and breathes life and meaning into the claims and should be accorded patentable weight. Specifically, per the Examiner’s suggestion, the term provides structural limitation to the claims by specifying that both the claimed tasks and subtasks are those of a financial institution.

As Applicants respectfully pointed out in previous communications, Clarke is a continuation-in-part of application No. 09/837,807 (hereinafter “the ‘807 application”), which provides no description related to financial institutions. Accordingly, with respect to the features relied on by the Examiner, **Clarke cannot enjoy the benefit of the filing date of the ‘807 application.** Since Clarke’s filing date is later than that of the instant patent application, Clarke is not an effective reference under §103.

In response, the Office Action correctly acknowledged that a financial institution is defined as “an established organization of or relating to finance,” but erred in contending that the factory production scheduling described in the ‘807 application is a “financial institution.” The Office Action contended:

Since Clarke in the 807 reference is accounting for and optimizing personal labor-hours [in a factory,] this relates to the liquid resources of an organization, since it affects the degree to which labor-hours and thus dollar cost is minimized by effective scheduling. Since the manufacturing organization discussed in the ‘807 reference has activities that relate to liquid resources (i.e. money), then the organization in 807 is as much a “financial institution as is termed in the claims.

See page 3, first paragraph of the Office Action.

This stretched contention expands beyond any common knowledge and understanding of the English knowledge, and tries to attach the label of “financial institution” to almost any

organization. According to the contention, it appears that any organization would be considered as “financial institution” simply by conducting activities that would marginally or remotely associated with any dollar cost. For instance, **under the Examiner’s construction, a school would be considered as “financial institution” because schools charge tuitions; the USPTO would be considered as “financial institution” because the USPTO charges application fees; and the CIA is a “financial institution” because it pays its employee salaries.** This type of expanded interpretations is off base and untenable. It is submitted that a factory as described in the ‘807 application is just that, a factory, and is not a financial institution. Accordingly, the ‘807 application provides no support to Clarke. Therefore, **Clarke cannot enjoy the benefit of the filing date of the ‘807 application.** Since Clarke’s filing date is later than that of the instant patent application, Clarke is not an effective reference under §103. The obviousness rejection based on Clarke should be withdrawn.

Furthermore, a *prima facie* case of obviousness under 35 U.S.C. § 103 requires three criteria be met. First, the references, when combined, must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation in the references themselves to modify the reference or to combine reference teachings. Third, there must be a reasonable expectation of success for the modification or combination of references. The teaching or suggestion to make the modification or combination of prior art and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As already acknowledged by the Examiner, Clarke fails to disclose every limitation of the claims. See page 5, second paragraph of the Office Action.

Furthermore, claim 9, after the amendment, describes a method for processing and analyzing information of tasks for performance by a financial institution. A plurality of subtasks

associated with each respective one of the plurality of identified financial institution tasks, needed for performance of the respective financial institution task are identified. Production rate information related to the amount of time or the number of staff needed to perform each of the identified subtasks is accessed. A total work volume for the tasks for performance by the financial institution is generated based on the identified subtasks and the production rate information for the identified subtasks. Staff availability is determined based on staff information, and a capacity report is generated based on the total work volume for the tasks for performance by the financial institution and the staff availability. The staff information includes at least one of information related to the number of employees, capability of a specific employee to perform the subtasks, information related to exempt status of employees, information related to staff outage, information related to work time that cannot be used to perform the subtasks, and information related to business days within a specific period of time. These features are not available in Clarke. Clarke does not identify a task for performance by a financial institution. Neither does Clarke identify a plurality of subtasks associated with each respective one of the plurality of identified financial institution tasks, needed for performance of the respective financial institution task. The system in Clarke also fails to access production rate information related to the amount of time or the number of staff needed to perform each of the identified subtasks, and does not generate a total work volume for the tasks for performance by the financial institution, based on the identified subtasks and the production rate information for the identified subtasks. No capacity report is generated by Clarke based on the total work volume for the tasks for performance by the financial institution and the staff availability.

The other two cited documents, Morgan and Thomson, do not alleviate the deficiencies of Clarke. Morgan was cited by the Office Action for its purported discussion of calculating work volume as the number of time units needed to perform the identified subtasks, providing a capacity

report and different types of information of employees; and Thompson was cited for its alleged disclosure of comparing work volume with available employees and calculating work time.

However, neither Morgan nor Thompson specifically disclose or suggest modifying Clarke in a specific manner to meet every limitation of the claims. Therefore, Clarke, even if combined with Morgan and Thompson, does not disclose every feature of claim 9.

Claims 30 and 47 include features substantially parallel to those of claim 9. Accordingly, claims 30 and 47 also are patentable over the documents of record for at least the reasons of claim 9. Claims 10-21, 31-40 and 48-56, directly or indirectly, depend on claims 9, 30 and 47, respectively, and incorporate every limitation thereof. Therefore, claims 10-21, 31-40 and 48-56 also are patentable for at least the same reasons as for claims 9, 30 and 47, as well as based on their own merits.

Claims 57-59 Are Patentable

New claims 57-59 depend on claims 9, 30 and 47, respectively, and further specify that the financial institution is a bank, a clearing house, a clearing center or an insurance company. Appropriate support for the new claims can be found in, for example, paragraph [003] of the written description. It is submitted that the documents of record fail to disclose or suggest these features. Accordingly, claims 57-59 are patentable for at least the same reasons as for claims 9, 30 and 47, as well as based on their own merits. Favorable consideration of claims 57-59 is respectfully requested.

Conclusion

For the reasons given above, Applicant believes that this application is conditioned for allowance and Applicant requests that the Examiner gives the application favorable reconsideration and permits it to issue as a patent. However, if the Examiner believes that the application can be put

in even better condition for allowance, the Examiner is invited to contact Applicant's representative listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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